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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/018,104	02/03/1998	JAMES L. HOBART	PHAN-00100	9278

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HAVERSTOCK & OWENS LLP
162 NORTH WOLFE ROAD
SUNNYVALE, CA 94086

EXAMINER

SHAY, DAVID M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/018,104

Applicant(s)

HOBART ET AL.

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 15, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17-24 and 41-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-24, and 41-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date May 13, 2002
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 19, 2004 has been entered.

Applicant argues that with the device of Dwyer it is "not feasible to alternate between pulse or sets of pulses in the time frame required to perform coagulation or ablation on a target area tissues as recited in the claim". The examiner must, respectfully disagree. Dwyer et al specifically teach that the device can both cut (ablate) and coagulate, and that the switching between the two functions can be done quickly (see column 3, lines 51-55).

Applicant continues arguing that claim 1 requires an apparatus "for delivering a series of laser pulses having a wavelength, the medical laser delivery apparatus" (emphasis in original) with a non-ablative laser pulse for coagulating to a controllable depth. The examiner first notes that comprising-type claim language allows for more than one wavelength to exist in the laser output even if a series of the pulses is at "a wavelength". Applicant is also respectfully reminded that the originally filed disclosure does not provide support for both laser sources producing pulses of the same wavelength (see the office actions mailed March 26, 2001 and September 17, 2001). With regard to the controllable coagulation depth, the examiner notes that the controllability of the coagulation depth is provided by controlling the exposure time of the tissue (see instant disclosure, the paragraph bridging pages 4 and 5), thus the exposure control of Dwyer et al, allowing the laser to be turned on and off "as desired" provides the claimed

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controllability, thus claim 1, which recites no specific time frame, still clearly anticipates claim 1 as amended. These comments also apply to amended claims 11 and 41.

Regarding the combination rejection, applicant argues that the references combined with Dwyer et al have been characterized previously and argues the allowability of all dependent claims flows from the allowability of their independent claims. The examiner firstly note that as claims 1, 11 and 41 are, in fact, not patentable over Dwyer et al, the dependant claims are similarly unpatentable over the combination as set forth more fully in previous rejections.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 5 has been renumbered 52. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 11 and 41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dwyer et al.

Claims 1-3, 8, 41, 43, 44 and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dew ('969) in combination with Anderson et al, and Belkin et al. Dew ('969) teaches the use of a carbon dioxide laser operating at 10.6 microns as a cutting laser in a laser system comprised of multiple lasers and teaches that the power of a pulse determines the amount of heat deposited in the tissue and that the same type of laser can be used for cutting and coagulating. Belkin et al teach that the carbon dioxide lasers operating at 10.6 microns can be

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used to heat rather than cut tissue. Anderson et al teach the way parameters such as absorptivity, spot size, and pulse width interrelate to control the amount of energy absorbed by tissue. It would have been obvious to the artisan of ordinary skill to use a carbon dioxide laser to coagulate in the device of Dew ('969), since this laser can be configured to coagulate as taught by Belkin et al, and since this would render the device more versatile, at no extra cost; and to employ the particular laser parameters claimed since these provide no unexpected results, and are within the scope of one having ordinary skill in the art as shown by Anderson et al; to employ an articulated arm with refocusing convex lenses since these are notorious in the art for transporting infrared radiation such as that from Carbon dioxide lasers, official notice of which has already taken; and to use a galvanometer to alternate the beams, since these are notorious for moving optical components official notice which has already been taken thus producing a device such as claimed.

Claims 1,6, 7, 11-13, 17, 18, 41 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Dwyer et al. Sklar et al teach the use of a graphic user interface for use with multiple lasers and teach that it can be used with any type of laser for any type of surgery and that the depth of laser action; energy per pulse; and repetition rate can be input and displayed. Dwyer et al provide a dual laser system with controllable spot size. It would have been obvious to the artisan of ordinary skill to employ the interface of Sklar et al in the device of Dwyer et al, since Dwyer et al provide no control interface for the device made up of two separate lasers or to employ the dual laser source of Dwyer et al in the system of Sklar et al, since Sklar et al provide no particular laser source, thus producing a device such as claimed.

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Claims 4, 9, 10, 42 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dew ('969) in combination with Anderson et al and Belkin et al as applied to claims 1-3, 8, 41, 43, 44, and 47-49 are above, and further in combination with Assa et al. Assa et al teach a scanning hand piece and the equivalence of carbon dioxide and Erbium YAG lasers. Thus it would have been obvious to the artisan of ordinary skill to employ a scanning hand piece as taught by Assa et al, since his allows more consistency of treatment and to employ an erbium laser, since these are equivalent to the carbon dioxide laser, thus producing a device such as claimed.

Claims 14 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dew ('969) in combination with Anderson et al and Belkin et al as applied to claims 1-3, 8, 41, 43, 44 and 47-49 above, and further in combination with Sklar et al. Sklar et al teach a user interface for a multi-laser system. It would have been obvious to the artisan of ordinary skill to employ the interface of Sklar et al, since no interface is taught and this would allow the surgical treatment to be preprogrammed, as taught by Sklar et al, thus producing a device such as claimed.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dew ('969) in combination with Anderson et al, Belkin et al, and Sklar et al as applied to claim 14 and 19-22 above, and further in combination with Assa et al. The teachings of Assa et al and the motivations for combination thereof are essentially those already iterated above. Thus it would have been obvious to the artisan of ordinary skill to combine those old and well known teachings to produce a device such as claimed.

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Applicant's arguments filed July 19, 2004 have been fully considered but they are not persuasive. The arguments are not convincing for the reasons set forth above.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number (571) 272-4773.



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330